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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

DECISION
ON PETITION

In re Application of:
Ki-Ook Park, et al.
Application Serial No.: 09/892,790
Filed: June 28, 2001
For: **PSEUDO CONTACT TYPE NEGATIVE
PRESSURE AIR BEARING SLIDER**

This is a decision on the duplicative petitions filed July 25, 2005, and the duplicative "corrected petitions" which were filed on July 26, 2005, which are treated as a Petition to the Director pursuant to 37 C.F.R. §1.181. No fee is required.

Petitioner objected to the refusal by the examiner to enter appellant's "Third Reply Brief" filed October 25, 2004.

The file record of the subject application reveals that an appeal brief from the examiner's final rejection (mailed July 9, 2002) was filed on December 9, 2002, along with an amendment which provided a listing of the claims in compliance with 37 C.F.R. §1.173. On February 27, 2003, an examiner's answer was mailed. On April 28, 2003 a reply brief was filed. A subsequent, substitute reply brief was then filed on May 8, 2003. On November 3 and 14, 2003, a communication was mailed from the Office indicating that the original reply brief and then the subsequent, substitute reply brief had been noted and entered. The application was then forwarded to the Board of Appeals and Interferences.

On February 2, 2004, the application was remanded from the Board of Appeals and Interferences for reconsideration of the recapture rejection in light of the recent precedential Board decision in *Ex parte Eggert*. On August 23, 2004, the Office mailed a communication to appellant, indicating that the recapture rejection with respect to claims 21 through 60 was withdrawn in light of the *Ex parte Eggert* decision. On October 25, 2004, appellants filed a renewed request for oral hearing and a "Third Reply Brief". On May 24, 2005, an Office communication was mailed indicating that the reply brief filed on October 25, 2004 would not be entered because it was not filed within two months of the mailing date of the Examiner's Answer and that the communication mailed August 23, 2004 did not re-open prosecution, but rather merely provided notice of the withdrawal of one of the rejections on appeal.

37 C.F.R. § 41.50 Decisions and other actions by the Board, states in part:

- (a)(1) The Board, ... may also remand an application to the examiner.
- (2) If a supplemental examiner's answer is written in response to a remand by the Board for further consideration of a rejection pursuant to paragraph (a)(1) of this section, the appellant must within two months from the date of the supplemental examiner's answer exercise one of the following two options to avoid sua sponte

dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:


(i) *Reopen prosecution.* ...

(ii) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as provided in § 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the examiner under paragraph (a)(2)(i) of this section. [emphasis added]

Although the examiner considered the communication of August 23, 2004 as merely a notification of withdrawal of a grounds of rejection, the communication addressed the removal of a ground of rejection from consideration by the Board and also addressed the status of the remaining grounds of rejection before the Board of Patent Appeals and Interferences. Hence the August 23, 2004 communication was in fact a supplemental examiner's answer. Therefore, in accordance with 37 C.F.R. §41.50 above, appellant was required to either file a request to reopen prosecution, or file a reply brief as provided in 37 C.F.R. §41.41 and request that the appeal be maintained.

Accordingly, petitioner's request to have the "Third Reply Brief" of October 25, 2004 entered and the appeal to be maintained, is Granted.

The application file will be forwarded to the examiner for consideration of the reply brief filed on October 25, 2004.



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